



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,008	10/10/2003	Alan J. Wheatley	T9475.NP.DIV	3219
20551	7590	03/20/2006	EXAMINER	
THORPE NORTH & WESTERN, LLP. 8180 SOUTH 700 EAST, SUITE 200 SANDY, UT 84070			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/684,008

Applicant(s)

WHEATLEY, ALAN J.

Examiner

Nasser Ahmad

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-60,65-73,78-85,98,99 and 101-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-60,65-73,78-85,98,99 and 101-108 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on November 18, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6673409 and Application serial No. 11/021560 have been reviewed and is accepted. The terminal disclaimer have been recorded.

### ***Rejections Withdrawn***

2. Claims 98-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Idland (4749222) in the last Office Action of September 23, 2005 has been withdrawn in view of the amendment and newly discovered prior art.

### ***Indicated Allowability Withdrawn***

3. Claims 49-60, 65-673, 78-85 and 100-108 indicated as being allowable in the last Office Action have been withdrawn in view of the newly discovered prior art.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 49-60, 65-673, 78-85 and 100-108 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1772

3. Claims 49-51, 53-60, 65-67, 98-99, 101-103 and 105-108 are rejected under 35 U.S.C. 102(b) as being anticipated by Peck (5899010).

Peck relates to a frictional holding device (12) comprising a pad having a bottom surface and a top surface, the top having a contoured surface over the majority of the top and includes a plurality of protrusions or indentations (figure-4, #24 or #25). The bottom surface is smoother than the top surface (figure-5). The pad is bendable or flexible (abstract). Figure-1 shows the presence of indicia (10) on the top surface. The surface between the protrusions are taken to be the flat section (claim 54). The pad can be of polyurethane, vinyl material, etc. (col. 3, lines 53-58). Said materials are known to be inherently translucent. The indentation shown in figure-4 is interpreted to be indicia on the bottom surface and said indicia are visible through the translucent pad.

The intended use phrases such as "to be disposed", "to removable receive", "to contact", "to conform", etc. have not been given any patentable weight because said phrases are not deemed to be of positive limitations.

Claims 59-60, 103, as stated, have not been given any patentable weight because the claimed elements are directed to an intended future use of the holding device.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 1772

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peck in view of Hendershot (4862944).

Peck, as discussed above, fails to teach that the bottom surface of the pad is tacky.

Hendershot discloses a sunshield of static cling material that has a tacky bottom surface (20) as shown in figures 2 and 4. therefore, it would have been obvious to one having ordinary skill in the art to utilize Hendershot's teaching of using a tacky bottom surface for the static cling pad in the invention of Peck with the motivation to provide for enhanced adherence of the pad to a surface such as a wall as shown in Peck, figure-6.

6. Claims 68-73 and 78-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timpson (6640477) in view of Peck.

Timpson relates to a method for releasably securing a banner on a vehicle surface comprising placing the frictional banner on a vehicle surface (abstract and col. 5, lines 15-17). However, Timpson fails to teach the placing of an item on the banner surface.

Peck, as discussed above, teaches the advantage of placing indicia items on the banner surface to display information thereon. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Peck's teaching of using indicia or item on the banner surface in the invention of Timpson with the motivation to provide display of information.

### ***Conclusion***

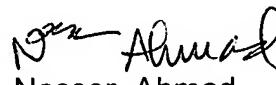
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

Art Unit: 1772

1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 3/16/06  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
March 16, 2006.